

REMARKS / DISCUSSION OF ISSUES

The Examiner's attention is requested to MPEP 706.07(a) "Final Rejection, When Proper on Second Action", wherein it is stated:

"Under present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by *applicant's amendment of the claims* nor based on information submitted in an *information disclosure statement* filed during the period set forth in 37 CFR 1.97 (c)".

The Office action introduces a new ground of rejection, and asserts that the applicants' amendment of the claims necessitated these new grounds of rejection. The applicants respectfully disagree with this assertion, and respectfully maintain that the applicants' prior amendment to the claims made no substantive changes to the claims. As noted in the applicants' prior response, the claims were amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language. The claims were not narrowed in scope and no new matter was added. Therefore, in accordance with MPEP 706.07(a), the applicants respectfully maintain that the finality of this second action is inappropriate, and, if the applicants' remarks below are not effective in having all of the claims deemed allowable, should be withdrawn.

Claims 1-17 are pending in the application.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph. The applicants respectfully traverse this rejection.

The Office action asserts that the term 'configured to' renders the claims indefinite. The applicants respectfully disagree with this assertion.

The term 'configured to' does not render a claim indefinite; contrarily, the term 'configured to' is the more appropriate form of an element of an apparatus claims. In the instant case, for example, the phrase "a synchronizer that is configured to synchronize a change in the signalling output with a clock of the clocked device" properly defines a limitation of an apparatus claim, and is more appropriate than the phrase that omits the 'configured to' language: "a synchronizer that synchronizes a change in the signalling output with a clock of the clocked device". The phrase 'synchronizes a change' is functional language, whereas 'is configured to synchronize a change' is structural language.

Of particular note, it could be argued that "a synchronizer that synchronizes a change" only does so when it is placed in functional use, receives a changed signal, and synchronizes it. As such, a manufacturer of an infringing device who does not actually place the device in an operational environment could argue that the manufacture of the device does not infringe such a claim. The applicants choose to use the 'configured to' form of the claim language for apparatus claims to avoid such an argument. In the above example, the manufacturer could not deny that the device as manufactured is configured to synchronize a change, because the device is so configured regardless of whether it is ever placed into operation and receives a signal to synchronize.

Because the term 'configured to' does not render a claim indefinite, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 1-16 under 35 U.S.C. 112, second paragraph.

The Office action rejects claims 1-4, 8-9, 14, and 17 under 35 U.S.C. 103(a) over Yetter (USP 5,392,423) and Durham et al. (USP 5,964,866, hereinafter Durham). The applicants respectfully traverse this rejection.

The Examiner's attention is requested to MPEP 706.02(j), "Contents of a 35 U.S.C. 103 Rejection", wherein it is stated that:

"the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification."

The applicants respectfully maintain that the Office action fails to identify the proposed modifications to Yetter and Durham to arrive at the applicants' claimed invention, and that the Office action fails to identify why one of skill in the art would have been motivated to make such a modification.

The Office action asserts that Yetter teaches the claimed mousetrap buffer, and that Durham teaches the claimed synchronizer. However, the Office action fails to identify "the signaling output for coordinating data exchange" from Yetter's mousetrap buffer, and fails to identify how Yetter's design would be modified to accept Durham's synchronizer for synchronizing a change in this signaling output with a clock of the device that provides the signaling output.

The applicants respectfully note that the synchronizing signals in Yetter are the clocks CK1 and CK2, which are inputs to the Yetter's mousetrap devices, and not output signals of these devices. As such, the applicants respectfully maintain that the combination of Yetter and Durham does not teach or suggest a device that includes a mousetrap buffer that includes a signalling output for coordinating data exchange between clocked device, and a synchronizer that synchronizes a change in the signalling output with a clock of one of the clocked devices, as specifically claimed in claim 1, upon which claims 2-16 depend. Claim 17 includes similar limitations.

Further, in *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**." *KSR*, slip op. at 14 (emphasis added).

The Office action asserts that it would have been obvious to add Durham's synchronizing unit to Yetter 'in order to better regulate the transfer of data', but fails to identify why one would assume that adding Durham's synchronizing unit to Yetter would provide a better regulation of the transfer of data. There is nothing in Yetter that would lead one of skill in the art to assume that addition of a synchronizing unit would improve Yetter's data transfer, or even that the addition of a synchronizing unit would be feasible in Yetter's design. The applicants respectfully maintain that an unsupported assertion that an improvement would be realized by the combination of Yetter and Durham does not satisfy the directive of the Supreme Court in *KSR* that an explicit analysis is required to support an assertion of an apparent reason for combining prior art references.

Because the combination of Yetter and Durham fails to teach the elements of each of the applicants' independent claims 1 and 17, and because the Office action fails to identify how or why Yetter's device would be modified to include Durham's synchronizing unit, the applicants respectfully maintain that the rejection of claims 1-4, 8-9, 14, and 17 under 35 U.S.C. 103(a) over Yetter and Durham does not satisfy the criteria of MPEP 706.02(j), and should be withdrawn.

The Office action rejects claims 5, 10-13, and 15-16 under 35 U.S.C. 103(a) over Yetter, Durham, and Singh et al. ("MOUSETRAP: Ultra-High-Speed Transition-Signaling Asynchronous Pipelines).

Each of these rejected claims is dependent upon claim 1, and in this rejection, the Office action relies upon Yetter and Durham for teaching the elements of claim 1. As noted above, the combination of Yetter and Durham fails to teach the elements of claim 1, and the Office action fails to identify how or why Yetter would be modified to include Durham's synchronizing unit. Accordingly, the applicants respectfully maintain that the rejection of claims 5, 10-13, and 15-16 under 35 U.S.C. 103(a) that relies upon Yetter and Durham for teaching the elements of claim 1 is unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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